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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/113,329	08/30/93	HARVEY	J 56348
			HARVEY, J. EXAMINER
THOMAS J. SCOTT, JR. HOWREY & SIMON 1299 PENNSYLVANIA AVE., N.W. WASHINGTON, DC 20006			26M1/0420
			ART UNIT PAPER NUMBER
			2602 10
			DATE MAILED: 04/20/95

**This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS**

- ☒ This application has been examined ☒ Responsive to communication filed on 2/17/95 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 (three) month(s), _____ days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☒ Notice of References Cited by Examiner, PTO-892. 2. ☐ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449. 4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.. 6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, 49-84 are pending in the application.
- Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 4, 6, 12, 14, 15, 21, 24-30, 41, 45-48 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 49-84 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other _____

EXAMINER'S ACTION

Art Unit: 2602

1. The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. **In re Sarett**, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); **In re Schneller**, 397 F.2d 350, 158 uspq 210 (CCPA 1968); **In re White**, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); **In re Thorington**, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); **In re Vogel**, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); **In re Ornam**, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); **In re Longi**, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 985); and **In re Goodman**, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

2. Claims 1-3, 5, 7-11, 13, 16-20, 22, 23, 31-40, 42, 44, and 49-84 are rejected under the judicially created doctrine of double patenting in view of claims 1-13 of U.S. Patent No. 4,694,490.

The subject matter recited in all of the claims of the present application was fully disclosed in the above identified U.S. Patent as has been explicitly argued by applicant in the second paragraph under the heading "REMARKS" on page 27 of the amendment filed 1/12/95. The allowance of the claims of the

Serial Number: 08/113,329

-3-

Art Unit: 2602

present application would extend the rights to exclude already granted in claims 1-13 of the U.S. Patent [ie at least for devices/methods encompassed by both sets of claims].

Specifically, the transitional phrase "comprising...A, B, C, and X" [where A,B,C, and X represent means/steps] in the claims of an application in fact extends patent coverage of a patent which claims "comprising...A, B, and Y" [where A,B, and Y are means/steps wherein only A and B are common to both sets of claims] because both claims have overlapping coverage on any method/apparatus which at least "comprises...A, B, C, X, andY".

Thus, the controlling fact is that the patent protection for the device, fully disclosed in and covered by the claims of the patent, would be extended by the allowance of the claims in the application. Furthermore, there is no apparent reason why applicant was prevented from presenting the claims in the application for examination during prosecution of the issued patent.

3. The prior art has been cited because it illustrates system which operated to automatically control the broadcast of video programming.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Harvey whose telephone number is (703) 305-4365.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

DEH 4/15/95

David E. Harvey
Examiner
Group 2602